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In the
SUPREME COURT OF THE UNITED STATES

October Term 1984

BERWYN E. ETTER,
Petitioner,

vs.

COMMISSIONER OF PATENTS AND TRADEMARKS,
Respondent,

ANTHONY E. B. GOODFELLOW,
Intervenor.

On Petition to the United States Supreme Court for Writ of Certiorari to the Court of Appeals of the Federal Circuit.

# SUPPLEMENTAL APPENDIX

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# SUPPLEMENTAL APPENDIX

TABLE OF CONTENTS PAGE NO.

Decision of the Board of Appeals of the United States Patent and Trademark Office 1-10

Art Unit 236 Paper No. 37

Appeal No. 556-68 fh

HEARD: January 26, 1984

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF APPEALS

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Ex parte Berwyn E. Etter

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Request filed February 4, 1982, Control No. 90/000,154, for the Reexamination of Patent No. 4,133,034, issued January 2, 1979, based on application Serial No. 819,350, filed July 27, 1977. Method and Means of Assimilating Utility Meter Data.

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Donald H. Zarley et al. for appellant.

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Primary Examiner - Errol A. Krass.

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Before Bennett, Spencer and Nusbaum, Examiners-in-Chief. Spencer, Examiner-in-Chief.

This appeal is from the decision of the Examiner finally rejecting claims 1 through 9. No other claims are presented.

Claim 1 is illustrative and reads as follows:

1. A method of assimilating utility meter data at the meter locations, comprising,

accumulating on an input information electronic storage means customer profile information for a plurality of meter customers, said profile information including the customer identity and account information,

placing said input information electronic storage means in a portable computer capable of being manually carried to the site of a given meter, said portable computer having an output information storage means and having the capability of updating, printing and presenting various of said customer profile information

for said meter customers before and after receiving current customer profile information,

actuating said computer to segregate and to visually present from the customer profile information for a plurality of meter customers stored on said input information electronic storage means at least the meter number and customer identity information of a given meter customer,

imposing into said computer the current meter reading of said given meter customer at the site of the meter being read,

actuating said computer to calculate the charge for utility usage based upon the previous meter reading and said current meter reading,

actuating said computer to print a bill for said meter customer at the site of said meter based upon said calculation and imposing on said output information storage means the updated customer profile information,

and depositing said bill at the service address of said given meter customer.

The references relied on are:

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| Boyce | 3,654,449 | Apr. 4, 1972 |
| Ambrosio | 3,932,730 | Jan. 13, 1976 |
| Hundley | 3,947,665 | Mar. 30, 1976 |
| Dallimonti | 4,001,807 | Jan. 4, 1977 |
| Azure | 4,016,542 | Apr. 5, 1977 |
| Ng et al. (Ng) | 4,025,766 | May 24, 1977 |

Claims 1 through 9 stand rejected under 35 USC 103. As evidence of

obviousness, the Examiner cites Ambrosio and Azure for claims 1, 2, 4, 5 and 9, Ambrosio, Azure and Hundley or Dallimonti for claim 3, Ambrosio, Azure and Boyce for claim 6 and Ambrosio, Azure and Ng for claims 7 and 8.

We make reference to the answer and two supplemental answers for the position of the Examiner and to the brief, reply brief and two supplemental reply briefs for the position of appellant.

## O P I N I O N

We have carefully reviewed the entire record before us and have given careful consideration to

appellant's extensive arguments. We find ourselves in full agreement with the Examiner and will affirm the rejections for the reasons set forth by him, as well as our additional comments infra.

Initially, we note that appellant draws no distinction as to patentability between the claims. Accordingly, all of the claims stand or fall together. In re Hellsund, 474 F.2d 1307, 177 USPQ 170 (CCPA 1973).

Appellant urges that the Examiner erred in not disqualifying himself from the instant reexamination proceeding. Appellant asserts that he has been prejudiced by the Examiner's involvement in other interrelated proceedings involving the patent under reexamination.

We fully agree with the Examiner that this is a petitionable rather than an appealable matter. We clearly lack jurisdiction to remand the application to another Examiner as appellant requests. We note, however, that there is nothing in the record which indicates that the Examiner's actions were prejudicial to appellant or that the proceedings below were detrimental to the interests of the public or appellant. The material in the Branning application which appellant considers slanderous is irrelevant to the determination of the obviousness/nonobviousness of the claims at bar over the cited prior art.

Appellant's arguments in traversal of the rejections are largely

predicated on the statutory presumption of validity. Appellant misconstrues the effect of the statutory presumption. The presumption is a procedural device, not substantive law. It does not have separate evidentiary value. Section 282 places the burden of going forward, as well as the burden of persuasion on the party asserting invalidity. Stratoflex Inc. v. Aeroquip Corporation. 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); SSIH Equipment, S.A. v. United States International Trade Commission, 713 F.2d 746, 218 USPQ 678 (Fed. Cir. 1983); Solder Removal Company v. United States International Trade Commission, 582 F.2d 628, 199 USPQ 129 (CCPA 1978). The introduction of new prior art,

whether it be more pertinent or less pertinent than the prior art considered during initial examination, can neither weaken nor strengthen the presumption of validity. The presumption of validity does not act as a shield or render the claims immune to attack by any prior art.

Appellant urges that an increased burden is placed on the Examiner in reexamination proceedings as compared to examination proceedings in view of the presumption of validity. Appellant cites no authority for this proposition and we know of none. In any examination proceeding, the burden of showing nonpatentability is on the Examiner. It is not apparent to us how such a burden can be

increased for reexamination proceedings. The statutes provide, in 35 USC 301, that "reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title." Section 1.550 of 37 CFR provides that examination will be conducted in accordance with sections 1.104-1.119. Sections 1.104-1.119 make no distinctions between examination and reexamination. The scope of reexamination is limited by 37 CFR 1.552 but, except for such limitations, the criteria for determining patentability under sections 102 and 103 are the same for reexamination and initial examination.

Appellant urges that the Examiner had Ambrosio and Jones before him during prosecution of the application which matured into the patent under reexamination and allowed the claims. Apellant further urges that Azure, if not less pertinent than Jones, is at most cumulative to Jones and, if the claims were allowable after a consideration of Ambrosio and Jones, they are allowable in view of Ambrosio and Azure. Appellant asserts that there has not been any satisfactory explanation of why the Examiner considered the claims to be patentable over Ambrosio and Jones in the original application and now considers the claims nonpatentable over Ambrosio and Azure.

We fully agree with the Examiner that Azure is more pertinent than Jones. Azure contains the teaching

"In a typical meter reading application it is required that the meter reader carry information (fixed data) with him related to each stop on his route for that day, including the house number, meter number, previous meter reading, a code for the location of the meter, and warning codes such as for a mad dog. This information can be loaded into the first field of each line of the memory of the electronic notebook from a computer, prior to proceeding on the route. The corresponding line then is displayed in use at each route stop, and the meter reading (variable data) would be entered into a second field."

No such teaching appears in Jones. In our view, the collective teachings of Ambrosio and Azure would have provided a much stronger suggestion for combining the teachings to provide the subject matter of claim 1 than would have the collective teachings of Ambrosio and Jones. Appellant should not construe this as meaning we consider the claims to be unobvious in view of Ambrosio and Jones.

Appellant relies on the affidavit of patentee Ambrosio as evidence that the modification of Ambrosio in view of Azure proposed by the Examiner would not have been obvious. We find the affidavit singularly unpersuasive. Patentee Ambrosio avers that, at the time of filing the application which matured into Ambrosio, "he had

knowledge of the computer concepts of ROM (read only memory) and RAM (random access memory), but it was not obvious to him that these concepts would have any utility in his invention other than as referred to in his patent."

The evidence for obviousness adduced by the Examiner is the collective teachings of Ambrosio and Azure. The combination of the teachings of Ambrosio and knowledge of the computer concepts of ROM and RAM is not the same or equivalent evidence. There is nothing in the evidence relied upon by patentee Ambrosio in arriving at the conclusion of nonobviousness which is equivalent to the Azure teaching that the fixed data required by a meter reader "can be loaded into

the first field of each line of the memory of the electronic notebook from a computer, prior to proceeding on the route."

Patentee Ambrosio also avers that "his appreciation of the ROM and RAM concepts in the fall of 1976 was no greater than at the time he filed his patent application," but says nothing about what was or was not obvious to him in the fall of 1976. This latter averment means hardly anything more than that patentee Ambrosio did not keep up with ROM and RAM developments during the two-year period.

At page 27 of the principal brief, appellant asserts, with respect to column 1, lines 47-60, of Azure (appellant's emphasis), "One having

ordinary skill in the art with knowledge of Ambrosio would learn nothing new from Azure's brief description of Ambrosio for that information was already conveyed by Ambrosio."

There is nothing in Azure to indicate that these lines are a description of Ambrosio. The filing date of Azure is more than 20 months prior to the issue date of Ambrosio. Ambrosio does not convey the information conveyed in these lines of Azure. In particular, Ambrosio does not convey the teaching of loading fixed data into the memory of an electronic notebook prior to the meter reader proceeding on his route. One of ordinary skill in the art would have manifestly learned something new from Azure.

Appellant relies on an affidavit by Gray as evidence of the nonobviousness of the claims at bar in view of Ambrosio and Azure. Gray states that the hardwired discrete logic technology disclosed in Azure was obsolete in the fall of 1976. This is irrelevant. The rejection is not predicated on incorporating the hardwired discrete logic circuitry of Azure into the Ambrosio device. It is based on the suggestion in the collective teachings of Ambrosio and Azure to employ electronic storage means in Ambrosio in lieu of punched cards. The fact that the microprocessor devices of Jones and Lowell would have presented more logical modifications of Ambrosio than would have the hardwire discrete logic based

device of Azure is equally irrelevant. Neither the claims nor the rejections have anything to do with the technology to be employed in modifying Ambrosio in view of Azure.

Gray uses language such as "one of ordinary skill in the art of Ambrosio, if seeking to update the Ambrosio concept, and if having the insight to look to the existing microprocessor art." This demonstrates a total lack of appreciation of the legal concept of obviousness. Obviousness is not determined by what a person of ordinary skill would have done if such a person were seeking to update an earlier concept and if such a person had the insight to look

to the relevant prior art. It is based on what the collective teachings of the relevant prior art would have suggested to a person of ordinary skill in the art who had full knowledge of the relevant prior art. In re Rosselet, 347 F.2d 847, 146 USPQ 183 (CCPA 1965).

The use of the legal term of art "obvious" by Gray, as well as by patentee Ambrosio, can be considered only as it is used in layman's parlance. In re Reuter, 651 F.2d 751, 210 USPQ 249 (CCPA 1981).

The largely irrelevant Gray affidavit is manifestly nonpersuasive.

Appellant's arguments that the lack of method claims in Ambrosio and

Azure is indicative of the nonobviousness of the method claims at bar are predicated on non sequitors. We ignore the remarks regarding Lowell since that reference is not prior art and it, therefore, has no bearing on the obviousness issue. The obviousness determination is based upon what is disclosed in the relevant prior art and what is suggested by the collective disclosures of the relevant prior art. The types of claims which appear in the prior art patents have nothing to do with the determination. Insofar as the claims at bar are concerned, neither Ambrosio nor Azure contains support therefor and such claims could manifestly not have been made in those patents.

Appellant's statement that Ambrosio could have included broad method claims which would have dominated the claims at bar is pure conjecture and not germane.

Appellant urges that none of the prior art includes the step of visually displaying the meter number. Appellant is incorrect. Azure states "[t]he corresponding line [fixed data including the meter number] then is displayed in use at each route stop." Ambrosio provides a visual display of the meter number on the punched card. One of ordinary skill in the art, in modifying Ambrosio in view of Azure to employ electronic storage, would have found it manifestly obvious to provide for display of the meter number.

Our reviewing court has held that claims in a reissue application enjoy no presumption of validity. In re Sneed, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983). We are not aware of any holding by that court or any other court on the question of whether or not claims in a reexamination proceeding enjoy a presumption of validity. Logically, there seems to be no reason for such a presumption to attach. The presumption is based on the recognized expertise of the Patent and Trademark Office (PTO) and, since that office has made a determination of patentability, a third party should properly have the burden of going forward and the burden of persuasion. No reason is

seen to accord the earlier determination of patentability by the PTO any greater weight than the later determination of nonpatentability by the PTO. We need not, however, decide the question of whether or not a presumption of validity attaches since, even if the claims at bar are accorded a presumption of validity, the Examiner has, in our view, carried any burden imposed by section 282.

## C O N C L U S I O N

The rejection of claims 1 through 9 under 35 USC 103 and the decision of the Examiner are affirmed.

AFFIRMED

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|---|---|
| /s/<br>Rodney D. Bennett, Jr.<br>Examiner-in-Chief | ) |
| /s/<br>Richard A. Spencer, Jr.<br>Examiner-in-Chief | ) BOARD<br>) OF<br>) APPEALS |
| /s/<br>Mark E. Nusbaum<br>Examiner-in-Chief | ) |

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